

### **REMARKS/ARGUMENTS**

Claims 1 to 18 are pending. Claims 2, 3 and 5 have been amended.

The Office Action stated that the following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The Examiner has not factually and/or legally proven in the record anticipation of any of applicants' claims. The Examiner has not proven a case of prima facie anticipation.

The Office Action stated that the following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



The Examiner has not proven in the record that any of applicants' claims are obvious to one ordinarily skilled in the art over the rejection reference and the prior art as a whole. The Examiner has not proven a case of prima facie obviousness.

The Office Action stated that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 (a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Examiner has not factually established in the record resolution (determination) of the level of ordinary skill in the pertinent art. Therefore, the obviousness rejection does not comply with the Supreme Court requirements. It has not factually and/or legally established in the record that applicants' claimed invention is obvious. Also, the Examiner has, therefore, not factually shown in the record establishment of prima facie obviousness of applicants' claimed invention.

The Office policy is to follow the Supreme Court's *Graham* decision in making determinations under Section 103(a). The obviousness rejection does not follow Office policy, hence the obviousness rejection is in error and should be withdrawn. The M.P.E.P., 2141.I, (Rev. 3), states:



“Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.” [Emphasis Supplied]

and also states:

“Accordingly, examiners should apply the test for patentability under 35 U.S.C. 103 set forth in *Graham*. See below for a detailed discussion of each of the *Graham* factual inquiries.”

The Section 103(a) rejection is incomplete and fails.

The Examiner has rejected all of the claims under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Shinagawa et al. (U.S. Patent No. 6,126,825). The rejections are set out in the alternative, and are not set out in an amalgamation of Section 102(a) and Section 103.

Section 102(a) and Section 103 are separate and independent sections of 35 U.S.C.

The Office Action stated:



“Applicants arguments filed March 6, 2006 have been fully considered but they are not persuasive. Applicants argue that the 102-3 rejection set forth by the examiner does not conform to the examination rules set forth under 35 U.S.C. 102(b) as anticipated by and under 35 U.S.C. 103(a). However, applicants must recognize that 102-3 rejection is not a pure 102(b) or a pure 103(a) rejection. A 102-3 rejection basically is a 102 rejection where some of the missing properties that can be inherently possessed by the applied prior art.” [Emphasis supplied] [Page 4]

This statement is clearly in error. There are only separate and independent so-called “pure” Section 102(b) and so-called “pure” Section 103(a) rejections. A “102/103” [or a “102-103”] rejection is not exclusively a Section 102 rejection where some of the missing properties can be inherently possessed by the applied prior art. Note that a so-called “pure” Section 102 rejection is established when a single prior art reference discloses, expressly or under the principles of inherency, all of the elements in a claimed invention. See below the quotation from the BOPAI’s Ex parte Fukumote et al. decision.

Under 35 U.S.C. (the patent statute) there is no such thing as a so-called “not a pure 102(b) or a pure 103(a) rejection”. The M.P.E.P., Section 706.02. IV, (Rev. 3), agrees.

Section 706.02. IV, (Rev. 3), of the M.P.E.P. states:

**“IV. DISTINCTION BETWEEN 35 U.S.C. 102 AND 103 ”**

“The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is



anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. See MPEP § 2131 - § 2146 for guidance on patentability determinations under 35 U.S.C. 102 and 103." [Emphasis supplied]

Section 2112, (Rev. 3), of the M.P.E.P. states:

"The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. 'The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.' *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)...." [Emphasis supplied]

Section 2112. III, (Rev. 3), of the M.P.E.P. states:

"SPECIFYING A PARTICULAR LEVEL OF SKILL IS NOT NECESSARY WHERE THE PRIOR ART ITSELF REFLECTS AN APPROPRIATE LEVEL."

"Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103,



expressed as a 102/103 rejection. 'There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102.' *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). The same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims."

[Emphasis supplied]

The *In re Best* decision, cited earlier by the Examiner, shows that the Examiner's assertion re a "102-3" rejection is incorrect and in error. A 102/103 rejection is concurrent rejections under Section 102 and under Section 103. This is the definition set out in the M.P.E.P. In the case at bar, the Examiner rejected under Section 102(b) "or, in the alternative", under Section 103(a) – hence, the Examiner's prior art rejections do not qualify as a 102-103 rejection.

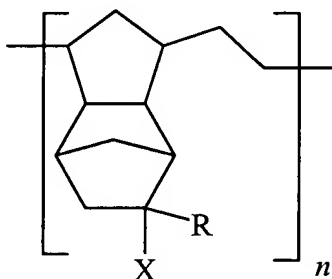
After receiving the Office Action the undersigned attorney left a telephone message for the Examiner that questioned the Examiner's position regarding the meaning of a 102/103 rejection. The undersigned attorney thanks the Examiner for calling back and providing that his explanation of the 102-103 rejection was an anticipation rejection that relied in part on inherency. The undersigned attorney disagreed and cited the statute and the M.P.E.P. to show that the Examiner's position was in error. The Examiner cited Section 2112.III of the M.P.E.P. to support his position. The undersigned attorney read the body of Section 2112.III to the Examiner to show that his definition of a 102-103 rejection was incorrect.



The Examiner said the he relied on the heading of Section 2112.III. However, such heading does not support the Examiner's position, and, furthermore, the body of such section defines a 102/103 rejection in a manner that destroys the Examiner's position.

Claims 1 to 18 have been rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Shinagawa et al. (U.S. Patent No 6,126,825) for the reasons adequately set forth from paragraph 4 of the Office Action of December 6, 2005. Applicants traverse this rejection.

The Office Action stated that the invention of Claims 1 to 18 relates to a **process for producing an optical film from a polyolefin** of the formula



in which at every occurrence of the substituents **R and X** they are either both **hydrogen** or **R is methyl and X is a polar group**, and **n is a number from 10 to 1000**, comprising the steps of

- (i) **dissolving the polyolefin** in an organic solvent or solvent mixture,
- (ii) **casting the solution onto a smooth substrate** in an atmosphere comprising at least 1 percent by volume of solvent vapor at a



temperature below the boiling point of the solvent, with substantially laminar gas flow being maintained over the smooth substrate,

(iii) **evaporating the solvent** from the cast solution to obtain a self-supporting film, and

(iv) **peeling the film away** from the substrate and drying at a **temperature rising to 70 to 140 ° C, without any resultant orientation of the film.**

Applicants traverse this statement. The highlighting and underlining of some portions of this statement has the effect of excluding other portions of applicants' claimed invention. This is an error. Section 103(a) [as well as Section 102(b)] requires consideration only of the claimed invention as a whole. The M.P.E.P., 2141.II, (Rev. 3), states:

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

\*\*\*." [Emphasis Supplied]

The Examiner, who has the burden of proof, has not factually established in the record a prima facie case of anticipation. The Office Action stated that this anticipation rejection is supported by the reasons set forth in the paragraph of the prior Office Action. However, such reasons of the Examiner establish and show that Shinagawa et al. does not anticipate any of the applicants' claims.

Page 4 of the prior Office Action states:

"Shinagawa et al. (col. 2, line 17-50) disclose a membrane (or film) comprises a polymer that is substantially identical to the one as claimed.



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Regarding the claimed 'optical film' feature, in view of the substantially identical composition of Shinagawa et al. and the composition claimed in applicants' process,...." [Emphasis supplied]

The Examiner's assertion of substantial identical composition (with which applicants traverse and disagree with) shows and establishes the lack of anticipation by Shinagawa et al. Section 102(b) requires identical composition in the prior art, and not merely substantially identical composition in the prior art.

Section 2131, (Rev. 3), of the M.P.E.P. states:

**"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM"**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." [Emphasis Supplied]

Even if the Examiner's assertion of "substantially identical composition" were correct (which it is not), there is no anticipation because as per the Examiner's admission, the composition of Shinagawa et al. is not identical to applicants' claimed invention.



If the Examiner means “identical”, not “substantially identical”, he should say so in the record and factually prove in the record that the Shinagawa et al. composition is identical to the claimed invention. The Examiner has not factually proven in the record that there is a prima facie case of anticipation so he still has the burden of proof.

Section 706.02. IV, (Rev. 3), states:

“In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” [Emphasis supplied]

The Board of Patents Appeals and Interferences, in its decision of Ex parte Fukumoto et al., Appeal No. 2005-2186 (non-precedential), stated:

“Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).” [Emphasis supplied] [Page 6]

The Examiner has not provided rationale or evidence to show inherency, hence there is no anticipation or obviousness due to Shinagawa et al.



The prior Office Action states:

“Since the film of Shinagawa et al. is to be used as a membrane, the examiner believes that the claimed ‘peeling the film away’ feature is inherent to the process of Shinagawa et al.” [Emphasis supplied] [Page 4]

Mere belief by the Examiner is mere conjecture or speculation that does not establish inherency. This collapse of the Examiner’s position shows lack of anticipation and obviousness.

Section 2112. IV, (Rev. 3), of the M.P.E.P. states:

**“IV. EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY”**

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). ‘To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that at certain thing may result from a given set of circumstances is not sufficient.” *In re*



*Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)...

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"In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Inter. 1990)...

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The examiner applied a U.S. patent....

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The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency." [Emphasis supplied]

The prior Office Action states:

"Regarding the claimed 'optical film' feature, in view of the substantially identical composition of Shinagawa et al. and the composition claimed in applicants' process, the examiner has a reasonable basis that the claimed 'optical film' feature is inherently possessed in Shinagawa et al." [Page 4]

The Examiner has not factually supplied in the record the required objective evidence or cogent technical reasoning to support his assertion of inherency. Self-serving assertions do not remove the burden of proof from the Examiner.



The Office Action states:

“Because applicants’ claimed “‘substantially laminar’” does not require laminar flow and that the ‘gentle wind’ or ‘breeze’ on Shinagawa et al. clearly indicate wind that is non-turbulence in nature, the examiner has a reasonable basis to believe that the claimed ‘substantially laminar’ feature of claim 1 is inherently possessed in Shinagawa et al.” [Page 4 to page 5]

It does not matter what the Examiner believes, and it does not matter that the Examiner asserts that he has a reasonable basis for what he believes. Inherency must be based on what is necessarily present in the prior art. Inherency requires objective evidence or cogent technical reasoning – both are lacking here. The Examiner has cited information from Shinagawa et al. that does not deal with a casting step.

Applicants’ claimed invention requires “casting the solution onto a smooth substrate in an atmosphere comprising at least 1 percent by volume of solvent vapor at a temperature below the boiling point of the solvent, with substantially laminar gas flow being maintained over the smooth substrate”.

Shinagawa et al. does not mention or deal with laminar gas flow, or even gas flow, during the casting step. Shinagawa et al. only mentions using a gentle wind or a breeze in the later step of evaporating the already-cast membrane. The prior Office Action did not assert that Shinagawa et al. teaches or even suggests using laminar gas flow or even mention gas flow. Shinagawa et al. does not teach or suggest applicants’ claimed invention as a whole.

Webster’s Ninth New Collegiate Dictionary, (1989), states:



**“laminar flow *n* (1935): streamline flow in a fluid near a solid boundary – compare TURBULENT FLOW” [Page 671]**

All of applicants' claims require casting with a laminar gas flow of an atmosphere containing at least 1 volume percent of the solvent; after casting, the solvent is evaporated from the cast solution. Shinagawa et al. states:

“The norbornene resin solution thus prepared is subjected to casting on a support such as glass plates, plastic films, or metal plates with the aid of an applicator so as to be 50 from 500 microns in thickness. When a low boiling solvent such as methylene chloride is used, the solvent is preferentially evaporated by exposing the solution membrane having undergone the casting to a gentle wind at about room temperature to cause phase separation in the solution, thus a microporous membrane being formed.” [Emphasis supplied] [Col. 6, line 63, to col. 7, line 4]

“A norbornene resin dissolved in such mixed solvents is subjected to casting on a support such as glass plates, plastic films, or metal plates with the aid of an applicator so as to be from 50 to 500 microns in thickness, and the solution membrane thus produced is gently dried by exposing the membrane to a breeze at room temperature or a lower temperature. This leads to preferential evaporation of a low boiling good solvent (c) to cause phase separation in the solution. Further, the membrane gels by the complete evaporation of the good solvent (c) to form a microporous membrane. The poor solvents (d) and water left are removed by heating.” [Emphasis supplied] [Col. 8, lines 24 to 35]



“A solution comprising 12 parts of norbornene resin (Arton G, manufactured by Japan Synthetic Rubber Co., Ltd.), 65 parts of methylene chloride, 21 parts of methanol, and 2 parts of water was prepared, and stretched on a glass plate in thin layer form with the aid of an applicator. The resulting membrane was exposed to a breeze maintained at 25 °C. for about 1 hr to form a microporous membrane and further to a strong wind maintained at 60°C. to dry.” [Emphasis supplied] [col. 9, lines 35 to 42]

All that Shinagawa et al. disclosed is that, after casting has been done, drying the already-cast material by evaporating solvent from the already-cast material by exposing the already-cast material to a “gentle wind” or “a breeze”. Shinagawa et al.’s disclosure does not deal with the casting step.

The Office Action stated that, regarding applicants’ argument that Shinagawa et al. is silent on a process that involves “substantially laminar gas flow being maintained over the smooth substrate”, applicants must recognize that Shinagawa et al. (col. 8, lines 24 to 35) clearly discloses a process involving a film (membrane) that is gently dried at room temperature with gentle wind (breeze) to produce a film that is isotropic in properties (col. 8, line 40). Applicants traverse this statement because it is in error several ways. But first note that the Examiner has admitted that the gentle wind/breeze of Shinagawa et al. is used to dry an already-cast film (membrane). Hence, Shinagawa et al. does not teach or suggest applicants’ claimed process.



Applicants' claimed process includes step (iii) of casting the smooth substrate while maintaining a substantially laminar gas flow of gas containing the solvent over the smooth substrate followed by step (iv) of evaporating the solvent from the already-cast membrane. The laminar gas flow containing the solvent in step (iii) prevents the start of step (iv) until the laminar gas flow containing the solvent is ceased. Shinagawa et al. only discloses using the flow of a gentle wind or breeze during a step of evaporating solvent from an already-cast membrane.

Nowhere does Shinagawa say that its film is "gently dried".

The Examiner has not supplied any facts in the record to support his assertion that the "gentle wind" or "breeze" provides a substantially laminar gas flow or a substantially non-turbulent gas flow. The Examiner is requested to factually support his assertion by citation of a supporting reference or his declaration to such effect, or to withdraw such assertion.

The issue of "gentle wind" or "breeze" is meaningless because it does not involve applicants' step (iii).

Shinagawa et al., in effect, makes applicants' claimed invention non-obvious. The Examiner has not factually established in the record a prima facie showing of obviousness.

The Office Action stated that, because applicants' claimed 'substantially laminar' does not require perfect laminar flow and that the "gentle wind" or "breeze" of Shinagawa et al. clearly indicates wind that is non-turbulent in nature. The Examiner has a reasonable basis to believe that the claimed "substantially laminar" feature of Claim 1 is inherently possessed in Shinagawa et al. Applicants



traverse this statement as being incorrect. The Examiner has admitted that the “gentle wind” or “breeze” deals with the drying step in Shinagawa et al, hence it is not a relevant disclosure as it does not deal with a casting step. Shinagawa et al. states “... the solution membrane thus produced is gently dried by exposing the membrane to a breeze....” and “...the solvent is...evaporated by exposing the solution membrane having undergone the casting to a gentle wind....” and “The resulting membrane was exposed to a breeze....”.

The prior Office Action stated that Shinagawa et al. (col. 2, line 17 to 50) discloses a membrane (or film) comprises a polymer that is substantially identical to the one as claimed. Applicants traverse this statement. The Examiner has not factually shown in the record that the membranes are substantially identical. Shinagawa et al. does not teach or suggest using laminar gas flow during casting.

The prior Office Action stated that, further, Shinagawa et al. (col. 4, line 56 to 67) discloses that the film can be prepared by dissolving the polyolefin in an organic solvent and casting the solution onto a substrate, and evaporating the solvent away. Applicants traverse the attempted implication of this statement because Shinagawa et al. does not teach or suggest the use of laminar gas flow during casting (and the Examiner has not even asserted that Shinagawa et al. does teach such).

The prior Office Action stated that, since the film of Shinagawa et al. is to be used as a membrane, the Examiner believes that the claimed “peeling the film away” feature is inherent to the process of Shinagawa et al. Applicants traverse this statement. The membrane might slide right off of the substrate of Shinagawa



et al.; there are many ways the membrane and the substrate may have been separated or automatically separate; to assert peeling is mere speculation and is not inherent. The Examiner has not factually established in the record that silence in Shinagawa et al. has to inherently and exclusively mean separation by peeling.

The prior Office Action stated that, regarding drying the film at a temperature rising to 70 to 140 °C, Shinagawa et al. (col. 7, line 35 to 43) clearly teaches heating the film to 70 °C to remove residual solvent. Applicants traverse this statement as being incorrect. Shinagawa et al. does not teach heat drying a membrane that has been peeled from the substrate (or prepared by casting using laminar gas flow). Shinagawa et al. deals with removing solvent from the membrane using a heated separate liquid wash solvent (e.g., isopropanol) (it does not dissolve the resin membrane); this has nothing with heat drying to remove solvent.

The prior Office Action stated that, regarding the claim "optical film" feature, in view of substantially identical composition of Shinagawa et al. and the composition claimed in applicants' process, the Examiner has a reasonable basis that the claimed "optical film" feature is inherently possessed in Shinagawa et al. Applicants traverse this statement. The Examiner has not factually shown in the record that the compositions are substantially identical. The Examiner has not carried his burden of proof. The Examiner's position is only speculation, which is insufficient under Section 103(a). The processes are different. The Examiner's rejection explanation does not even involve applicants' claim limitation of casting using laminar gas flow. There is no teaching or suggestion in Shinagawa et al.



that its microporous membranes involve or are an optical film. Why would one ordinarily skilled in the art want a microporous membrane when such a person is seeking to produce an optical film? The Examiner has not answered this question.

It is quite clear to a person of ordinary skill in the art that the microporous membranes of Shinagawa et al. are not suitable as, or suggestive of, optical films. An optical film has to be transparent and non-porous while the microporous membranes of Shinagawa et al. are opaque or at best translucent (cf. Example 1, column 8, last line: "The **white** membrane formed..."). The process of Shinagawa et al. requires either casting at a high temperature with subsequent extraction of the casting solvent with another solvent in which the polymer is insoluble (cf. Claim 3) or using a mixture of a good solvent having a low boiling point, a poor solvent having a higher boiling point than the good solvent, and water as (cf. Claim 5), see column 6, line 54 through column 7, line 47. The Examiner has used forbidden hindsight to try to pick bits and pieces from the disclosure of Shinagawa et al., while ignoring the parts of Shinagawa et al. that establish that the disclosure of Shinagawa et al. clearly teaches the error in the Examiner's incorrect selective choosing of text of Shinagawa et al., and tried to unsuccessfully reassemble them to arrive at something that is similar to the present claim invention.

The Office Action stated that, regarding the claimed "optical" feature, applicants argue that the film prepared has been phase separated, applicants fail to recognize that the film prepared is microporous and has a thickness of from 50 to 500 microns (col. 8, lines 24 to 35). Applicants traverse this statement as being of no supportive value to the Examiner's incorrect position. The cast membrane of



Shinagawa et al.'s Example 1 was "white" and was solid (thrown into water to rapidly cool). The white microporous solid membrane certainly was at best opaque or at best translucent and not transparent as required for optical films. The incorrect and unfounded speculation of the Examiner is not the same as the factual evidence required.

The Office Action stated that, with film having the thickness as disclosed in Shinagawa et al., the Examiner has a reasonable basis that the transmission of light should not be impeded, especially when the composition of the film of Shinagawa et al. is substantially identical to that of Claims 1 to 18. Applicants traverse this statement, and point out above that the facts of Shinagawa et al. destroys the Examiner's assertions.

The prior Office Action stated that, since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. Applicants traverse this statement. The Examiner has incorrectly attempted to shift the burden of proof to applicants on the ground that the Patent Office does not have testing facilities. Since 1999 this ground is no longer viable. 35 U.S.C. 2(b) states:

"(b) SPECIFIC Powers.—The Office—

\* \* \*

"(3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;



(4)(A) may make such purchases, contracts for the construction, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle 1 and chapter 33 of title 40, title III of the Federal Property and Administrative Services Act of 1949 (41 U.S.C. 251 et seq.), and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.);

\* \* \*

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf; [Emphasis Supplied]

The Patent Office now has authority to conduct, or have conducted, tests at other governmental agencies, international organization, etc. Therefore, the Best decision rational is no longer valid. The burden of proof is still on the Examiner.



The Office Action stated: that regarding applicants' argument (page 5, March 6, 2006) that *In re Best* is no longer viable because the USPTO has the authority to conduct searches to collect proof, the Examiner disagrees; and that, because the argued quotation (page 5, March 6, 2006) does not indicate anywhere that the USPTO has the proper facilities to conduct any experimental work, the argued *In re Best* set forth stand proper. Applicants traverse this statement as being in error. The C.C.P.A. in the *In re Best* decision stated:

“...its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products.” [Page 434]

The Patent Office now has statutory authority to set up such manufacturing and laboratory facilities, or to use such facilities of other Federal agencies, etc. So the basis of the *In re Best* decision no longer exists. It is not the fault or responsibility of applicants that the Patent Office has not set up such facilities or arranged to use such facilities of other Federal agencies. The Examiner has the burden of proof and he has not carried it.

The prior Office Action cited *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); and *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). The basis for these cases no longer exists.

The prior Office Action stated that further, regarding the claimed “for optical film”, applicants must recognize that a recitation of the intended use of the claimed invention must result in structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior



art. Applicants traverse this statement as not being supported by Section 103(a).

The Examiner has not made a prima facie case of obviousness or anticipation.

The prior Office Action stated that, if the prior art structure is capable of performing the intended use, then it meets the claim. Applicants traverse this statement. Process claims are involved.

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

Aug. 8, 2004  
Date

Virgil H. Marsh  
Virgil H. Marsh  
Reg. No. 23,083

Fisher, Christen & Sabol  
1725 K St. NW  
Suite 1108  
Washington, DC 20006  
Tel.: 202-659-2000  
Fax: 202-659-2015

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Leslie Stepany  
FISHER, CHRISTEN & SABOL  
1725 Street, N.W., Suite 1108  
Washington, D.C. 20006